

REMARKS

This Application has been carefully reviewed in light of the Final Official Action mailed September 22, 2004. At the time of the Final Office Action, Claims 1-32 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-5, 7-8, 16-20, 22-28, and 3-31 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,475,679 issued to Munter (hereinafter “*Munter*”) in view of U.S. Patent No. 5,583,894 issued to Linsley (hereinafter “*Linsley*”) and further in view of U.S. Patent No. 5,892,764 issued to Riemann et al. (hereinafter “*Riemann*”). The Examiner rejects Claims 6, 21, and 29 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Linsley* and further in view of U.S. Publication No. 2003/0165147 issued to Shimada (hereinafter “*Shimada*”). The Examiner rejects Claims 9, 11, and 13-15 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Riemann*. The Examiner rejects Claims 10, 12, and 32 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Riemann* and further in view of U.S. Patent No. 6,094,430 issued to Hoogenboom (hereinafter “*Hoogenboom*”). These rejections are respectfully traversed for the following reasons.

The Examiner is respectfully reminded that he has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to M.P.E.P. §2143, to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.¹ As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness.

Independent Claim 1 recites, in part, monitoring the first and second serial-to-parallel converters in order to determine when one or more words of the respective data sets have accumulated in each of the first and second serial-to-parallel converters; writing one or more of the words that have accumulated in each of the first and second serial-to-parallel

¹ See generally M.P.E.P. §2143.

converters to a selected one of first and second memory banks; and monitoring, by a single scheduler, the first and second memory banks to determine when enough of the words that were written to each of the first and second memory banks have formed one or more cells.

Such teachings are simply not found in *Munter*, or in any of the other cited references used to support the §103 rejection. In contrast to the teachings of Independent Claim 1, *Munter* discloses a high capacity ATM switch for switching data between input ports and output ports in a variable length train of digital cells, each input and output port handling one or more channels and each cell comprising a fixed number of bytes and including a channel indication therein. The switch includes an input buffer at each input port for separately storing trains of digital cells destined for output ports and for sending a connection request through a control link to switch core means. In response to the connection request from one or more input buffers, the switch core means makes and breaks high speed data link connections between the input ports and the output ports at desired times and indicates by way of the control link to each input buffer when to send the train of digital cells stored therein. The switch also includes an output buffer at each output port, which separately stores cells of bytes received from the switch core means and destined to the channel in response to the channel indication of each cell. (See *Munter*, Column 2, lines 42-60.) With respect to the monitoring operations, as recited in Independent Claim 1, the Examiner has failed to point out anything in *Munter* that is germane to the patentability of the pending claims. Instead, the Examiner improperly refers to the potential for such an operation in *Linsley*. However, evaluating the passage referred to by the Examiner more closely reveals that the teachings of *Linsley* could not possibly inhibit the patentability of Independent Claim 1.

In contrast to the teachings of Independent Claim 1, *Linsley* discloses that the overlap of the address counters in the preferred embodiment is possible without data corruptions because address counters 23 and 24 count data units. The most significant six bits of the data unit count is used as a dual port memory address to address memory locations in dual port memory 25. The least significant three bits refer to the data unit (bits) within each memory location. Address comparator 55 compares only the six-bits of the dual port memory addresses. Thus, comparator 55 will find an address difference between addresses in address counter 23 and address counter 24 of zero when input counter 23 is counting the first data unit within a particular eight bit word to be stored in dual port memory 25 and output counter

24 is counting a last data unit in a word currently stored in dual port memory 25 at the address to be written by input counter 23. There is no conflict because the new data is not written into dual port memory 25 until all the data units for the eight-bit word have been accumulated by serial to parallel logic 21. Thus, provided there are no pauses in clock 15, the output counter 24 will complete reading out the last unit of data in the eight-bit memory location before all the data units for the new eight-bit word is accumulated and written into the memory location. In embodiments of *Linsley* where the data unit is the same width as data words stored in dual memory port 25, address counter 23 and address counter 24 are not allowed to overlap. Additionally, in such cases, serial to parallel logic 21 and parallel to serial logic 26 are unnecessary. (See *Linsley*, Column 7, lines 10-36.)

The Examiner has extracted a single sentence from the passage of *Linsley* in an effort to combine its irrelevant teachings with the subject matter of *Munter*. *Linsley* does not relate to monitoring as disclosed by Independent Claim 1. Instead, as evidenced above, *Linsley* deals with an arbitrary capacity in the context of a different type of communications architecture. For at least this reason, Independent Claim 1 is patentable over the proposed *Munter-Linsley* combination. Additionally, Independent Claims 16 and 25 recite a limitation that is similar to that identified above and are, therefore, also patentable over the proposed combinations for analogous reasons.

Moreover, Applicant notes that with respect to the first criterion of non-obviousness, the Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of making the combination.² Thus, the fact that the teachings of one reference (*Munter*) would improve the teachings of any other reference (*Linsley*, *Riemann*, etc.), as posited by the Examiner, does not provide the required suggestion to make such a combination. Nothing in *Munter* or in any other cited reference suggests or motivates the proposed combinations. Nor has the Examiner provided any evidence that suggests any of the proposed modifications.³ The

² See M.P.E.P. §2143.01.

³ The Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. §2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. §2144.03.

Examiner merely speculates, “it would have been obvious” to make the proposed combinations. The Examiner is merely interjecting a subjective conclusory statement in an improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the combination as is required by Federal Circuit case law.⁴ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁵

Furthermore, the Examiner is precluded from modifying the combined teachings of *Munter*, *Linsley*, *Riemann*, *Shimada*, and *Hoogenboom* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.⁶ The fact that the modification is possible or even advantageous is not enough.⁷ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.⁸

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Munter* and any of the references of record would not be capable of performing the operations required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Linsley* could provide the monitoring functions within the architecture of *Munter*. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that

⁴ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not “evidence.” *Id.*

⁵ See M.P.E.P. §2145. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references.”); see also *In re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”

⁶ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

⁷ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

⁸ *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

the proposed *Munter-Linsley, Riemann, Shimada, or Hoogenboom* combinations would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a *prima facie* case of obviousness.

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly by the Applicant in the tendered analysis provided *supra*. Therefore, Applicant respectfully submits that claims 1-32 are patentably distinct from the proposed combinations. All of the pending claims have been shown to be allowable, as they are patentable over all of the references of record. Notice to this effect is respectfully requested in the form of a full allowance of claims 1-32.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If, however, this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,
BAKER BOTT S L.L.P.
Attorneys for Applicant



Thomas Frame
Reg. No. 47,232

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Customer No. **05073**